

Remarks

Entry of the above-noted amendments, reconsideration of the application in accordance with the concurrent Request for Continued Examination, and allowance of all claims pending are respectfully requested. Following the entry of this amendment, claims 1-5, 7-11, 20, 22, 24-30, 32, 34-39, 45 and 46 will be pending.

Applicant's arguments presented below focus on certain patentable differences between the invention as claimed and the applied references. However, it is not to be inferred that the failure to argue all differences between the claimed subject matter and the applied references constitutes acceptance of assertions made in the Office Action of alleged similarities between elements of the claimed subject matter and the applied references.

Claim Rejection - 35 U.S.C. §112, first paragraph:

Claims 1-12 were rejected under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification in a way to enable one skilled in the art to make and/or use the invention. A question was raised in the Office Action regarding the voice message being already stored in the first mobile terminal. In accordance with the flexible acceptance as per claim 1, an initial voice message originated from another mobile terminal having the first mobile terminal as its destination is stored at the communication application server and not initially delivered to the first mobile terminal. This operation is consistent with the teachings of an embodiment of the present invention in the subject specification. See page 3, (Summary the Invention), lines 13-17; also see steps 326, 328, 338, 342, and corresponding descriptions of the steps in the specification. Thus, the subject matter does not constitute new matter and is in compliance with 35 U.S.C. 112, first paragraph. Therefore, withdrawal of this rejection as to claim 1 and its dependent claims is requested. For similar reasons, the subject matter of independent apparatus claim 7 and its dependent claims is also in compliance with 35 U.S.C. 112, first paragraph, and the withdrawal of the rejection of these claims is also sought.

Claim Rejection - 35 U.S.C. §103:

All pending claims were rejected under 35 U.S.C. 103 based on Dahod (US 20040224678) in view of Markki (US 20040127203). Claims 24 and 34 were rejected under 35 U.S.C. 103 based on Dahod in view of Markki and Mathis (US 20030119540). These rejections are respectfully traversed, and at least some of the reasons for withdrawing the rejections are explained below.

Claim 1

Claim 1 is directed to a method implemented by a push-to-talk wireless mobile terminal that is in the position of a recipient of incoming calls. A determination is made if a first input from a user of the first mobile terminal has been made requesting selectable acceptance management for incoming calls not yet initiated to the first mobile terminal. If the request has been made, the first mobile terminal transmits a first control message to a communication application server. The first control message represents an instruction to implement selectable acceptance of future incoming calls to the first mobile terminal. Selectable acceptance includes storing at the communication application server an initial voice message associated with the incoming call to the first mobile terminal. The initial stored voice message is transmitted to the first mobile terminal from the communication application server during a real-time communication session only upon the communication application server receiving a playback signal from the first mobile terminal where the playback signal is distinct from another signal generated by the first mobile terminal upon a depression of a push-to-talk button on the first mobile terminal. Thus, a request must be transmitted from the first mobile terminal to the communication application server before the initial voice message from the calling party will be delivered to the first mobile terminal from the communication application server. Further, this request is not a PTT signal from the first mobile terminal.

Dahod is directed to **reducing the perceived latency** in a half-duplex wireless communication system **for the calling party**. That is, the objective is to minimize perceived time delay

between the time a calling party makes a request to communicate and the time when the calling party is authorized to start speaking a voice message to be delivered to the called party. This is accomplished by giving the originating user approval to start speaking the initial voice message before the real-time communication link with the called party has been established. This requires temporarily storing the initial voice message from the calling party until a real-time communication path with the called party is established. Once the path is established, i.e. the called party's communication device answers, the initial stored voice message is transmitted to the called party. See Dahod, FIG. 2 and FIG. 3, steps 1006-1012 and 1004.

It is important to note that Dahod is directed to an improvement in perceived latency for the call originating party and provides no benefit to the called party. Thus the objective of Dahod is counter to the objective of the present invention as per claim 1 in which the improvement in flexible acceptance is for the benefit of the called party. Hence one of ordinary skill in the art would not look to the teaching of Dahod when considering the problem addressed by the present invention. Dahod does not address the same or similar problem addressed by the present invention.

One of ordinary skill the art would understand that the "answer" by the called party's device in Dahod is either (1) a successful communication link handshake with the called party device or (2) a manual "answer" by the called party entered by pushing the PTT button after the path has been established. Neither of such actions satisfies the required playback signal of claim 1 which is required before the stored voice message will be delivered to the called party's mobile device in the real-time communication session. Selectable acceptance per claim 1 gives the called party the selectable option of listening to the initial voice message from the originating party without having to transmit a PTT signal which would ordinarily start bi-directional communications with the calling party.

This gives the called party "presence privacy", i.e. it prevents the calling party from discerning that the called party listened to his initial voice message. Thus, the called party can elect to listen to the initial voice message and then decide based on the message whether to decline establishing

communications with the originating party without the originating party knowing that the called party listened to the initial voice message.

The ability to send a communication to a voice mail system when the called party is unavailable, as relied upon in the Office Action, does not teach of the requirements of claim 1. In fact sending a communication to a voice mail system teaches away from the invention of claim 1. The very purpose of the selectable acceptance feature of claim 1 is to give the called party the option of listening to the initial voice message of the calling party at the time it is offered as part of a real-time communication session. Diverting the communication to a voice mail system is contrary to this objective. Hence, a suggestion in Dahod of sending a communication to a voice mail system teaches away from the requirements of claim 1.

FIG. 5 of Dahod shows the flow diagram associated with the recipient mobile. In the first step at 1030 the recipient mobile receives notification of an incoming PTT call. In the later step at 1032, the recipient mobile responds to the notification signal with answer/accept the call. Therefore, Dahod does not teach that a determination is made at the recipient mobile of how to control incoming calls not yet initiated to the mobile.

Markki is directed to context sensitive call processing. Application data is converted into profile data format in accordance with the profile data syntax. A common syntax allows different software applications to be used to process calls. In the Office Action it is alleged that Markki teaches that a call processing server can determine if there is profile data in a call preference database prior to processing a call, which is alleged to read on the "second determining step". Applicant respectfully traverses this conclusion.

Markki presents a general model by which incoming calls are processed according to a set of rules. Three examples are mentioned in the description with regard to call processing: ringer type, volume, and activate voice mail. None of the three actual examples are equivalent to the required limitations in accordance with claim 1.

Merely providing a processing environment (Markki) by which a specific technique might be implemented is clearly not sufficient to form *prima facie* support for obviousness. That is, there is nothing explicitly stated in Markki (or Dahod or the combination) that would direct one of ordinary skill in the art to the limitations of claim 1. If the view taken in the Office Action with regard to the teachings of Markki was sustainable, then there could be no further patentable subject matter with regard to the processing of calls. Such an attempted broad application of the teachings of Markki is not permitted.

For example, assume that a computing architecture is disclosed that supports a broad-based computing language capable of implementing a wide variety of processes. Is this enough to support an obviousness rejection of a new specific computer implemented process, not specifically disclosed in the computing architecture document, where said computing language would have been capable of implementing the new specific process? Clearly not.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) MPEP 2112. (Emphasis added)

Although the above case was directed primarily to inherency, it is important to note that the court found that the mere fact that a certain thing may result from a set of circumstances is not sufficient to support a rejection. In the subject application, the same principle is applicable. That is, the mere fact that Markki supports general processing actions from which a particular processing action might result is not sufficient.

It is an axiom that it is the language and limitations in the claim that defines the invention which must be disclosed by the teachings of the prior art. The fact that a structure/step disclosed in a prior art document might have been capable of implementing a structure/step recited in a claim does not provide *prima facie* support for an obviousness rejection absent a specific teaching of the recited limitation or its equivalent. In the current situation, Markki merely provides a general

architecture without a specific teaching or suggestion of the recited limitations of claim 1. Further, it in combination with Dahod does not teach or suggest the recited limitations of claim 1. Thus, because Markki does not provide a sustainable teaching of the recited limitations in claim 1 for which it is applied, it does not provide a *prima facie* ground for support of the obviousness rejection of claim 1.

Claims 3-5

Dependent claims 3-5 provide additional specific limitations which provide patentable distinctiveness when considered in combination with a respective parent claims.

Independent claim 7 and dependent claims 9-10

Independent claim 7 and dependent claims 9-10 are believed to be allowable for similar reasons explained above with regard to independent claim 1 and dependent claims 3-5.

Independent claims 20 & 30

Claim 20 is directed to the method implemented by a communication application server and claim 30 to the server itself for practicing the method. These claims are allowable for similar reasons explained above for claims 1 and 7.

Independent claims 45 & 46

These claims are directed to a method and apparatus, respectively, that process communications among users in a push-to-talk communication network. These claims contain patentable subject matter for similar reasons explained above for claims 1 and 7.

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In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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